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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,396	03/19/2001	Peter Holscher	SCH 1706	2405

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EXAMINER

FORD, JOHN M

ART UNIT PAPER NUMBER

1624

DATE MAILED: 11/05/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/787396

Applicant(s)

Holcher et al

Examiner

J.M. Ford

Group Art Unit

1624

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on 10.17.02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1, 6--15 and 17--22 is/are pending in the application.  
Of the above claim(s) 11--15 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1, 6--10 and 17--22 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1624

Applicants response of October 17, 2002, is noted.

The claims in the application are claims 1, 6--15 and 17--22.

What is the purpose of the proviso statements at the end of claim 1? Applicants claim too close to the compounds removed by exception.

"When R6 is methyl." R6 could be hydrogen or ethyl. Each structurally obvious variations.

R5 is hydrogen but R5 could be methyl. A structurally obvious variation. R1 is not 6 (4-aminobenzyl amino methyl).

Look at R1 = (CHR<sub>n</sub>)<sub>n</sub>, n is 0, 1, 2, 3, 4, 5 or 6, if in the above exclusion n is not 1 (the methyl) methylene. The ethylene is an obvious variation. The position isomers are obvious variations. Why 4 - amino? A is C1-C6 alkylene. Those alkyl variation methylene vs ethylene are obvious variations.

In regard to side chain variations, i.e. n, A or p, it has been long established that this type of structural relationship-varying the size of a linking carbon chain- is per se obvious. Specifically, In re Shetty, 195 USPQ 753, In re Wilder, 195 USPQ 426, and Ex parte Gresham, 121 USPQ 422 all feature a compound with a C2 link rejected over a compound with a C1 link. Similarly, In re Chupp, 2 USPQ 2nd 1437 and In re Coes, 81 USPQ 369 have C1 link unpatentable over a C2 link. Ex parte Ruddy, 121 USPQ 427 has a C3 link unpatentable over a C1 link. Ex parte Nathan, 121 USPQ 347 found the insertion of a C2H4 link obvious. In all of these cases, the variation was per se obvious and did not require a specific teaching.

Art Unit: 1624

The next adjacent compound would be structurally obvious. See, *In re Dillon*, 919 F.2d at 696, 16 U.S.P.Q. 2d at 1904. See also *Deuel*, 51 F.3d at 1558, 34 U.S.P.Q. 2d at 1214 (“Structural relationships may provide the requisite motivation or suggestion to modify one compound to obtain another compounds. For example, one compound may suggest its homologs, because homologs often have similar properties, and, therefore, chemists of ordinary skill would ordinarily contemplate making them to try to obtain compounds with improved properties, or merely to satisfy their production goals.

Other structural similarities have been found to support a prima facie case of obviousness. E.g., *In re May*, 574 F.2d 1082, 1093-95, 197 U.S.P.Q. 601, 610-11 (CCPA 1978) (stereo isomers); *In re Wilder*, 563 F.2d 457, 563 F.2d 457, 460, 195 U.S.P.Q. 426, 429 (CCPA 197) (adjacent homologs and structural isomers); *In re Hoch*, 428 F.2d 1341, 1344, 166 U.S.P.Q. 406, 409 (CCPA 1970) (acid and ethyl ester); *In re Druey*, 319 F.2d 237, 240, 138 U.S.P.Q. 38, 41 (CCPA 1963) (omission of methyl group from pyrazole ring).

A compound need not be a homolog or isomer of a prior art compound in order to be susceptible to a rejection based on structural obviousness.

Thus, a difluorinated compound was held unpatentable over the prior art di chloro compound on the basis of analogical reasoning. Ex parte Wiseman (POBA 1953) 98 U.S.P.Q. 277.

*In re Nomiya*, 184 USPQ 607, provides that it is reasonable to conclude that the compounds removed by exception are known.

Art Unit: 1624

We reject on compounds, not citations. It is, therefore, reasonable to reject the presently claimed compounds as obvious (35 U.S.C. 103) from the compounds removed by exception, whether we know the citation of the compounds or not.

Therefore, claim 1 is rejected as obvious (35 U.S.C. 103) from the compounds removed by exception.

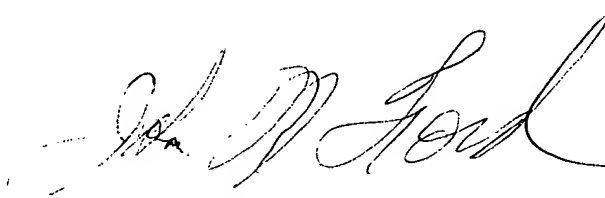
Claims 2--10 and 17--22 are rejected for the reasons claim 1 was rejected.

Claims 11-15 stand withdrawn under 37 CFR 1,142(b). The application cannot be allowed until <sup>claims</sup> 11--15 have been canceled.

The first species of claim 10 is a position isomer. 3-amino methyl benzyl amino methyl is a position isomer of compounds removed by exception. The species of claim 10 are very close to the compounds removed by exception. (35 USC 103) See the discussions, above; pp. 2 & 3.

John M. Ford:jmr

October 31, 2002

  
JOHN M. FORD  
PRIMARY EXAMINER  
GROUP - ART UNIT 1624